

***First Action Interview
Office Action Summary***

Application No.

10/584,816

Applicant(s)

REIDENBERG ET AL.

Examiner

Kevin S. Orwig

Art Unit

1611

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The MAILING OR NOTIFICATION DATE of this communication appears on the cover sheet with the correspondence address.

THE SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE **ONE MONTH OR THIRTY (30) DAYS**, WHICHEVER IS LONGER, FROM THE MAILING OR NOTIFICATION DATE OF THIS COMMUNICATION.

This time period for reply is extendable under 37 CFR 1.136(a) for only ONE additional MONTH.

☐ Applicant's request to not have a first-action interview is acknowledged (or the time period for reply set forth in the Pre-Interview Communication has expired and the Office did not receive any reply).

Status

- 1) ☒ Responsive to communication(s) filed on 8 April 2010 and interview conducted on 14 October 2010.
2) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 3) ☒ Claim(s) 1-13, 18, 19, 21-23, 31, and 32 is/are pending in the application.
3a) Of the above claim(s) _____ is/are withdrawn from consideration.
4) ☐ Claim(s) _____ is/are allowed.
5) ☒ Claim(s) 1-13, 18, 19, 21-23, 31, and 32 is/are rejected.
6) ☐ Claim(s) _____ is/are objected to.
7) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 8) ☒ The specification is objected to by the Examiner.
9) ☒ The drawing(s) filed on 27 June 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
10) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 11) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

Contact Information

Examiner's Telephone Number: (571)270-5869
Examiner's Typical Work Schedule: IFP
Supervisor's Name: Sharmila Landau
Supervisor's Telephone Number: (571)272-0614

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 7/28/10, 8/18/10.
4) ☒ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

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Notification of Rejection(s) and/or Objection(s)

#	Claim(s)	Reference(s) (if applicable)	Rejection Statutory Basis	Brief Explanation of Rejection
1	1-13, 18, 19, 21-23, 31, 32		112 2nd	Clms. 1 and 3: "...effective amount..."; clm. 22: "...rubber- like..."
2	1-13, 18, 19, 21-23, 31, 32	AA, AC, A, B	102(b)/103(a)	Granger (Ref AA on IDS of 12/26/06) discloses the inventive concept of the claimed invention, but is silent to the particle size of the encapsulated antagonist. However, adjustment of the particle size is not inventive. See further discussion below.
3	1-13, 18, 19, 21-23, 31, 32	AA, AC, A, B	Double Patenting	10/476601; 11/865387. The selection of the salt/free base form of the active agents is within the purview of the skilled artisan. Moreover the prior art teaches the claimed forms.

Expanded Discussion/Commentary

2		In combination with Granger, any of Oshlack (Ref AC on IDS of 9/20/07), Sackler (Ref A on 892), and/or Gale (Ref B on 892) render obvious the optimization of the particle size to the claimed ranges. Additionally Granger recognizes the benefit of making the antagonist difficult to separate from the agonist. Thus, any skilled artisan would appreciate that making the antagonist particles visually indiscernible would accomplish this goal.

DATE:	/Kevin S Orwig/ Examiner, Art Unit 1611	
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